

REMARKS

Reconsideration of this application, based on this amendment and these following remarks, is respectfully requested.

Claims 40, 41, and 53 through 55 remain in this case. Claims 53 and 55 are amended. Claim 41 stands allowed.

Claims 53 through 55 were rejected under §112, ¶2 as indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Claim 53 was specifically rejected because the phrase "a method transmitting data" was unclear. Claim 53 is amended in this paper to insert the word "of" into this phrase, as suggested by the Examiner. No new matter is presented by this amendment, and Applicants submit that this amendment to claim 53 is in no way narrowing.¹ Applicants respectfully submit that amended claim 53 is now sufficiently definite to meet the requirements of §112, ¶2.

Claim 55 was specifically rejected because the phrase "the permissible data transmission rate" lacked antecedent basis. Claim 55 is amended to now recite the further limitation, relative to claims 53 and 54 upon which it depends, that step (a) transmits the downstream data at a data transmission rate of at least ten million bits per second, and canceling the objectionable phrase. The specification clearly supports this amendment to claim 55,² and as such no new matter is presented. Applicants further

¹ See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 62 USPQ2d 1705 (2002), *on remand*, 304 F.3d 1289, 64 USPQ2d 1698 (Fed. Cir. 2002).

² See specification of S.N. 10/052,964 as published as US 2002/0122437 A1, paragraph [0118].

submit that this amendment is in no way narrowing,³ and that claim 55 is now sufficiently definite to meet the requirements of §112, ¶2.

For these reasons, Applicants submit that the §112 rejection of claims 53 through 55 is overcome by the amendment to claims 53 and 55, and that these claims are sufficiently definite as to meet the requirements of §112.

Claim 40 was rejected under the judicially created doctrine of double patenting of the obviousness type, relative to claims 1 and 2 of U.S. Patent No. 5,557,612. The Examiner found that the data request information of claim 40 corresponds to the communication access request of the patent claims, and that claim 40 omits the limitation of using a modulation scheme that does not require equalization that is required by the patented claims, and that such differences are obvious variations of one another.

Claims 53 through 55 were also rejected under the judicially created doctrine of double patenting of the obviousness type, relative to claims 1 and 2 of U.S. Patent No. 5,680,394. The Examiner found that the providing of periodic downstream and upstream communications in sequential order and setting the permissible data transmission rates of at least ten million bits per second were both an obvious design choice, and that the settling period of claim 54 corresponds to the quiet period of the patented claims.

Applicants submit a Terminal Disclaimer, executed by an authorized person on behalf of Texas Instruments Incorporated, disclaiming the terminal part of any patent granted on this application which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 5,557,612 or of U.S. Patent No. 5,680,394, subject to the stated limitations. This Terminal Disclaimer indicates the basis for its filing under 37

³ Festo, *supra*.

C.F.R. §3.73 in that this application was assigned to Amati Communications Corporation and that Amati Communications Corporation has since been merged with and into Texas Instruments Incorporated, by operation of merger as stated in the Certificate of Ownership and Merger submitted with that Terminal Disclaimer. The prior patents U.S. Patent No. 5,557,612 and U.S. Patent No. 5,680,394 were also assigned to Amati Communications Corporation, and because of the merger of Amati Communications Corporation with and into Texas Instruments Incorporated by operation of merger as stated in the Certificate of Ownership and Merger submitted with the Terminal Disclaimer, are therefore commonly assigned with this application. Applicants respectfully submit that this Terminal Disclaimer is sufficient to overcome the obviousness-type double patenting rejection of claims 40 and 53 through 55.

Applicants do not acquiesce to the double patenting rejection of claims 40 and 53 through 55, nor should the submitting of this Terminal Disclaimer be interpreted as an admission that Applicants agree with the findings and conclusion of the Examiner in such rejection. Indeed, Applicants note that the obviousness-type double patenting rejection of claim 40 in particular is deficient. Specifically, there is no statement or finding by the Examiner that the transmitting of the data transmission request signal from a selected first remote to the central unit during a particular symbol in a data frame that is associated with the selected first remote unit on at least one sub-channel that are not otherwise in use by any of the remote units, as required by claim 40, is either present in or an obvious variation of the patented claims. However, the Terminal Disclaimer is submitted in order to advance the prosecution of this application, and considering that the effective filing date of this application is at least as early as the effective filing date of the asserted prior patents U.S. Patent No. 5,557,612 or of U.S. Patent No. 5,680,394.

Applicants note that the cover sheet to the Office Action indicates that the action is in response to the Preliminary Amendment filed May 4, 2004. But there is no indication in the Office Action that the amendment presented in that Preliminary Amendment was in fact entered. The undersigned will operate on the presumption that the Preliminary Amendment was entered, and that the claim of priority presented in that paper has been accepted by the Patent and Trademark Office. However, an express statement to that effect, in the next paper from the Patent and Trademark Office, is respectfully requested, so that the file of this application can be clear.

The prior art cited as pertinent but not applied has been considered, but is not felt to come within the scope of the claims now in this case.

For these reasons, Applicants submit that all claims in this case are in condition for allowance. Reconsideration of this application is therefore respectfully requested.

Respectfully submitted,



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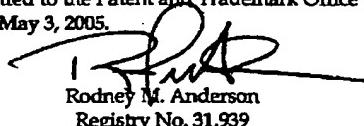
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CERTIFICATE OF FACSIMILE TRANSMISSION

37 C.F.R. 1.8

The undersigned hereby certifies that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax Number 703-872.9306) on May 3, 2005.



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